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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,042	03/31/2004	Masaaki Miyamoto	251291US0X CONT	4137

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

BOYKIN, TERRESSA M

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 08/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/813,042	Applicant(s) MIYAMOTO ET AL.	
	Examiner Terressa M. Boykin	Art Unit 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

Applicant's arguments/amendments with respect to previously rejected claims have been considered and are appreciated. In view of an additional/updated search, the following new rejection follows:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-21 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 06248067 see abstract, translation ; or JP 2000063507 see abstract, translation.

JP 06248067 discloses a process for preparing a polymer having excellent hue and strength by transesterifying a dihydric hydroxy compound with a carbonate compound while changing the reaction temperatures of a first reaction zone and a second reaction zone and supplying an inert gas. The process includes: (A) A dihydric hydroxy compound (e.g. bisphenol A) 1 and (B) a carbonate compound (e.g. diphenyl carbonate) 2 are melted in melting tanks A and B, supplied to a first reaction tank C, an inert gas 3 in a ratio of the gas to the component A of 0.01-20 by weight is fed to the

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first reaction tank at 100-280°C reaction temperature and transesterification reaction is carried out to form a reaction mixture containing a low-molecular weight carbonate having 1,000-25,000 viscosity-average molecular weight. Then the reaction mixture is sent to the second reaction tank, the reaction temperature is made higher than that of the first reaction tank, an inert gas 4 in the ratio of the gas to the component A of 0.002-10 by weight is supplied to the reaction tank at 200-350°C and transesterification reaction is carried out to give a polycarbonate having 10,000-50,000 viscosity-average molecular weight.

JP 2000063507 discloses a process to continuously obtain a polycarbonate excellent in hue and little in foreign matter by reacting an aromatic dihydroxy compound with a diester of carbonic acid in the presence of a specific catalyst using a specific device and specifying its viscosity-average molecular weight. The objective compound having 10,000-20,000 viscosity average molecular weight and $\leq 1,000$ ppm of terminal hydroxyl groups is continuously produced by transesterifying an aromatic dihydroxy compound expressed by formula I [B is a 1-15C hydrocarbon, a halogen-substituted hydrocarbon, -S-, -CO- or the like; X is a halogen, a 1-14C alkyl, a 6-18C aryl or the like; (m) is 0 or 1; (y) is 0-4] with a carbonic acid diester expressed by formula II [A and A' are each a 1-18C aliphatic, substituted aliphatic or a (substituted) aromatic group] in the presence of a catalyst comprising 1×10^{-8} - 1×10^{-5} mole of an alkaline (earth) metal compound based on the ingredient A.

Translations for the Japanese patents have been provided for applicants convenience. The structural formulas, the viscosity average molecular weights, as well as the transesterification processes appear to anticipate applicants claimed invention. Since the polycarbonates appear to be identical it would be reasonable to make hollow

containers including bottles etc. since such use is vastly used in the polycarbonate art. In view of the above, there appears to be no significant difference between the references and that which is claimed by applicant(s). Any differences not specifically mentioned appear to be conventional. Consequently, the claimed invention cannot be deemed as novel and accordingly is unpatentable.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Terressa Boykin whose telephone number is 571 272-1069. The examiner can normally be reached on Monday through Friday from 6:30am to 3:00pm.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. The general information number for listings of personnel is (571-272-1700).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Examiner Terressa Boykin

Primary Examiner

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